## REMARKS

Claim 7, 13-14, 20-29, 78, 89, 146, and 148 have been amended. No claims have been cancelled pursuant to this paper. Thus, claims 7-29, 78-89, and 146-149 are pending in the present application.

### Claims Rejections – 35 U.S.C. § 103

Claim 7, 13-14, 20-29, 78, 89, 146, and 148 have been amended to more accurately describe applicants' invention and to correct minor typographical errors within the claims.

Claims 7-29, 78-89, and 146-149 have been rejected under 34 U.S.C. § 103(a) as being unpatentable over Japanese Patent Publication No. 61-14557 to Hatanaka et al. in view of U.K. Patent Application GB 2088832A to Fujii et al., and further in view of U.S. Patent No. 5,394,992 to Winkler and U.S. Patent No. 5,761,089 to McInerny.

An obviousness rejection under §103 requires that all the limitations of a claim must be taught or suggested by the prior art. M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974)). A *prima facie* case of obviousness, *inter alia*, requires:

(i) a "suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," and

(ii) that "the prior art reference[s] . . . must teach or suggest all the claim limitations."

*See* M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)).

Claims 7-29, 78-89, and 146-149 recite using a plurality of "closely spaced magnetic sensors" for evaluating currency. Hatanaka does not disclose, teach, or suggest using even one magnetic sensor to evaluate currency. Rather, Hatanaka discloses optically recognizing a pattern on a bill without even detailing how this optical pattern is recognized. *See* Hatanaka at p. 7, ¶ 2. Similarly, Winkler fails to disclose, teach, or suggest magnetically evaluating currency and does not even mention authenticating or denomination a currency bill.

While Fujii, in passing, states that an abnormal magnetic pattern can be detected, Fujii in no way details how this may be performed. *See* Fujii at p. 1, line 112. Fujii does not disclose, teach, or suggest utilizing "closely spaced magnetic sensors" as specifically claimed by applicant

in every pending claim. Further, Fujii does not disclose, teach, or suggest the distinction between a normal/abnormal pattern or even what the pattern is.

Finally, McInerny does not disclose, teach, or suggest using a plurality of "closely spaced magnetic sensors" to evaluate currency. McInerny only discloses utilizing a magnetic field detector to scan the magnetic ink bearing portions of the currency. *See* McInerny at col. 8, lls. 44-45; col. 9, lls. 33-35, 57-58; col. 12, lls. 6-10.

Neither Hatanaka, Fujii, Winkler, McInerny, nor a combination thereof disclose, teach, or suggest a currency evaluation device having a plurality of "closely spaced magnetic sensors." Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made and that claims 7-29, 78-89, and 146-149 are patentable over Hatanaka in view of Fujii, and further in view of Winkler and McInerny under 35 U.S.C. § 103(a) for at least this reason.

Further, none of the cited references disclose, teach, or suggest magnetically scanning to "detect the presence of a security thread within each of the bills" or "determine the location of the security thread within the bill" as specifically claimed in claims 7-29. In fact, McInerny only discloses utilizing a magnetic field detector to scan the magnetic ink bearing portions of the currency. *See* McInerny at col. 8, lls. 44-45; col. 9, lls. 33-35, 57-58; col. 12, lls. 6-10. McInerny discloses that once the ink bearing portions have been scanned, the evaluation in based on the distance from the end of one ink bearing portion of the pattern to the beginning of the next ink bearing portion. *See* McInerny at col. 9, lls 37-40. Thus, McInerny merely looks at the location of the two ink bearing portions in relation to one another. McInerny does not disclose, teach, or suggest detecting a security thread. Additionally, because McInerny merely compares the relative locations of the two objects, McInerny cannot determine the location of a single security thread within the bills.

Fujii, in passing, states that an abnormal magnetic pattern can be detected, but Fujii in no way details how this may be performed. *See* Fujii at p. 1, line 112. Significantly, Fujii makes no mention of a magnetic thread or the detection thereof. Likewise, neither Winkler nor Hatanaka mention magnetic sensors or the detection of magnetic threads.

Neither Hatanaka, Fujii, Winkler, McInerny, nor a combination thereof disclose, teach, or suggest magnetically scanning to "detect the presence of a security thread within each of the bills." Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not

been made and that claims 7-29 are patentable over Hatanaka in view of Fujii, and further in view of Winkler and McInerny under 35 U.S.C. § 103(a) for at least this reason.

Furthermore, claims 78-89, 146, and 147 require that "the plurality of magnetic sensors cover a substantial portion of a long dimension of the bill." Clams 148 and 149 require "at least two magnetic sensors being adapted to scan a substantially continuous segment of each of the currency bills, the substantially continuous segment being parallel to the wide edge of the currency bills." Referring to McInerny FIG. 4, the single magnetic read-head 86 does not scan a substantial portion of a long dimension of the bill and does not scan a substantially continuous segment of each of the bills that is parallel to the wide edge of the currency bills. Further, Fujii discloses, teaches, or suggests nothing regarding the positioning of any magnetic sensors. Likewise, neither Winkler nor Hatanaka mention magnetic sensors at all. Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been made, and that claims 78-89 and 146-149 are patentable over Hatanaka in view of Fujii, and further in view of Winkler and McInerny under 35 U.S.C. § 103(a) for at least this reason.

Provisional Obviousness-Type Double Patenting Rejections

Claims 7-29, 58-89, and 146-149 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 164-327 of copending Application No.'s 09/541,170 and 09/542,287; claims 169-187, 189-190, 192-201, 221-224, 234-248, 250-257, 268-272, 277-285, 301-305, 312-314, 317-319, and 322-329 of copending Application No. 09/611,279; claims 1-30 of copending Application No. 09/607,109; claims 7-29, 78-89 and 146-149 of copending Application No. 09/684,103; claims 1-30 of copending Application No. 10/242,573; and claims 1-85 of copending Application No. 10/242,237. The Applicants respectfully traverse these rejections.

As the Applicants set forth in their three prior replies, an obviousness-type double patenting rejection requires the claims of the pending application to be compared to the claims of an application or a patent. *See* M.P.E.P. § 804. As discussed with the Examiner in the telephone interview of December 9, 2003, the claims of the present application require, *inter alia*, "closely spaced magnetic sensors." The Examiner has nowhere compared this limitation, recited in every claim in the pending application, with any of the cited claims in the copending applications.

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | | | |
|---|---|---|---|---|
| Application No. | : | 09/684,103 | Confirmation No. | : 3137 |
| Applicant | : | Douglas U. Mennie et al. | | |
| Filed | : | October 5, 2000 | | |
| TC/A.U. | : | 3653 | | |
| Examiner | : | Jeffrey A. Shapiro | | |
| Docket No. | : | 47171-00271USP1 | | |
| Customer No. | : | 30223 | | |



## PETITION FOR ONE-MONTH EXTENSION OF TIME

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF FACSIMILE
37 C.F.R 1.8

I hereby certify that this correspondence for Application Serial No. 09/684,103 is being sent by facsimile to The U.S. Patent and Trademark Office via fax number 703-872-9306 on the date shown below.

July 14, 2004 (Date) Joanne Bisson (Signature)

Dear Commissioner:

It is requested that the period for responding to the Office Action dated June 15, 2004 be extended one month from June 15, 2004 to and including July 15, 2004.

The Commissioner is authorized (except for payment of the issue fee) to charge $110.00 to the deposit account for payment of the Petition for One-Month Extension of Time from JENKENS & GILCHRIST, P.C. Deposit Account No. 10-0447 (47171-00271USP1). A duplicate copy of this Transmittal is enclosed for that purpose.

Respectfully submitted,

Date: July 14, 2004

Paul R. Kitch
Reg. No. 38,206
Attorney for Applicant
JENKENS & GILCHRIST, P.C.
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Chicago, IL 60606
(312) 425-3900

Thus, the Applicants respectfully request that these obviousness-type double patenting rejections be withdrawn as discussed with the Examiner.

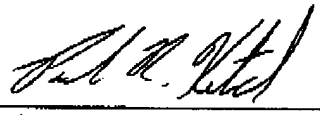
## Conclusion

In conclusion, the Applicants respectfully submit that all claims are in condition for allowance and such action is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned attorney at the number indicated.

The Applicants believe that no fee is due in connection with this paper. Applicants have attached a Petition for One-Month Extension of time to extend the period for response to July 15, 2004. The Commissioner is authorized to charge the deposit account (except for payment of the issue fee) of $110.00 to cover the Petition for One-Month Extension from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447(47171-00271USP1).

Respectfully submitted,



Dated: July 14, 2004

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